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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/094,949	06/15/1998	DWIGHT A. MERRIMAN	1153	9057

26646 7590 08/13/2002

KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

HARLE, JENNIFER I

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/13/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/094,949

Applicant(s)

MERRIMAN ET AL.

Examiner

Jennifer I. Harle

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 85-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 85-100 are pending. Claims 85-100 are rejected for the reasons set forth in the previous Office Action, mailed February 20, 2002, and incorporated, herein, by reference. As claim 100 merely changes the preamble from a method to a computer system for advertisement selection, claim 100 remains rejected for the reasons set forth in the previous action. Whether it is a computer system utilizing the means for clauses or a method utilizing the means for clauses, the means for would still be the same as previously set forth. This action is **made final**.

### ***Response to Arguments***

Applicant's arguments filed June 20, 2002 have been fully considered but they are not persuasive. Applicant argues only the independent claims 85, 90, 95, and 100. The dependent claims are never separately addressed or argued. To the extent that they rely upon the rationale well known in the art as the motivation to combine the teachings, these arguments are deemed waived, as they should have been addressed in this Office Action.

Applicant argues that the independent claims. 85, 90, 95, and 100 are patentably distinguishable over Kohda, et al. because the phrase "receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements" is not taught or suggested. Applicant further argues that the examiner's characterization of Kohda, et al. is incorrect because the advertising agent's Web server does not receive feedback from the advertiser's Web server but rather the advertising agent's Web server receives user activity information from the user's modified Web

Art Unit: 3627

browser, which captures this information when the user clicks on an anchor, i.e. link, in a Web page. However, the click-throughs/utilization of links to reach the advertiser's own Web page is feedback from the advertiser's Web server because the click-through/link counted, i.e. "user activity" as defined by Applicant, is a direct result of the advertiser's Web site and thus is feedback from the advertiser's Web server – regardless of the means used to capture the data, in this case a filter on user's machine passing on the information to the advertising agent. Thus, this argument is not persuasive.

Additionally, applicant argues that to the extent that user activity information, i.e. click-through/utilization of links, appears to be shared between Kohda's advertising agent and an advertiser, it is the advertising agent that provides such information to the advertiser. The examiner has never argued that point. In fact, that is the specific reason/deficiency pointed out in the §103 rejection, i.e. that Kohda, et al. does not teach utilizing this information as a means of selecting the advertisement. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has failed to address the combination of references; therefore, this argument is not persuasive.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jih  
August 9, 2002

  
Richard Chilcot  
~~Supervisory Patent Examiner~~  
Technology Center 285  
3602